

Remarks

This Application has been carefully reviewed in light of the Final Office Action dated September 17, 2004. Although Applicants believe all pending claims are allowable over the prior art of record without amendment, Applicants have made clarifying amendments to Claims 8 and 29-30. Certain of these amendments are not considered narrowing, and none are made in relation to patentability. Furthermore, Applicants respectfully submit that none of these amendments raise new issues or require the Examiner to perform a new search and that all of these amendments will place the Application in better condition for appeal; thus, Applicants respectfully request that the Examiner enter these amendments. Applicants respectfully request reconsideration and allowance of all pending claims.

I. Confirmation of Applicants' Election of Claims 8-18 and 29-30

Applicants confirm the election, made without traverse during a telephone conversation with Examiner Myhre on September 9, 2004, of the invention of Examiner's Group II, Claims 8-18 and 29-30, for prosecution on the merits. This election is made to expedite issuance of a patent from this Application. Applicants do not necessarily agree with or acquiesce to the Examiner's conclusions regarding the grouping of the claims. Claims 1-7, 19-28, and 31-32 are withdrawn without prejudice or disclaimer for prosecution in a divisional application if necessary.

II. The Finality of the Office Action should be Withdrawn

Applicants respectfully submit that the finality of the Final Office Action should be withdrawn because various rejections made for the first time by the Examiner in the Final Office Action were not timely and were not provoked by Applicants' amendments made in the previous Response.

A. The Rejection of Claims 8-18 and 29-30 under 35 U.S.C. § 101 is Not Timely

The Examiner did not reject Claims 8-18 and 29-30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter until the Final Office Action. Applicants' amendments to the claims made in the previous Response did not provoke these rejections. Although Applicants believe Claims 8-18 and 29-30 recite patentable subject matter without amendment, Applicants have submitted certain amendments to Claims 8-18 and 29-30 in this

Response to further clarify that these claims recite computer-implemented methods performed using one or more computer systems and are clearly directed to patentable subject matter. Applicants would have made these amendments in response to the first Office Action had the Examiner raised these grounds of rejection at the outset.

Unless the finality of the Final Office Action is withdrawn, these amendments are entered, and this Response is considered, Applicants will have had no meaningful opportunity to respond to these rejections in a single prosecution. Applicants respectfully submit that this is contrary to the M.P.E.P.'s instruction that "[p]iecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds" M.P.E.P. § 707.07(g). Furthermore, M.P.E.P. § 2106, which relates to patentable subject matter and computer-related inventions, states:

It is essential that patent applicants obtain prompt yet complete examination of their patent applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability *in the initial review of the application*, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, *Office personnel should state all reasons and bases for rejecting claims in the first Office action* A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

(emphasis added)

B. The Rejection of Claims 8-18 and 29-30 under 35 U.S.C. § 112, Second Paragraph, is Not Timely

Similarly, the Examiner did not reject Claims 8-18 and 29-30 under 35 U.S.C. § 112, second paragraph, as being indefinite until the Final Office Action. Applicants' amendments to the claims made in the previous Response did not provoke these rejections. Although Applicants believe Claims 8-18 and 29-30 comply with 35 U.S.C. § 112, second paragraph, without amendment, Applicants have submitted certain clarifying amendments to Claims 8 and 29 in this Response. Applicants would have made these amendments in response to the first Office Action had the Examiner raised these grounds of rejection at the outset.

Unless the finality of the Final Office Action is withdrawn, these amendments are entered, and this Response is considered, Applicants will have had no meaningful opportunity

to respond to these rejections in a single prosecution. Applicants reiterate the applicable sections of the M.P.E.P. cited above in Section II.A of this Response.

C. The Double Patenting Objection of Claims 9 and 29 is Not Timely

Similarly, the Examiner did not object to Claim 29 as being a substantial duplicate of Claim 9 until the Final Office Action. Applicants' amendments to the claims made in the previous Response did not provoke this objection. Although Applicants do not necessarily agree that "Claim 29 contains the exact limitations of Claim 8, plus the additional limitation of Claim 9," as asserted by the Examiner, Applicants have amended Claim 29 in this Response to include additional limitations. Applicants would have made these amendments in response to the first Office Action had the Examiner raised this objection at the outset.

Unless the finality of the Final Office Action is withdrawn, these amendments are entered, and this Response is considered, Applicants will have had no meaningful opportunity to respond to this objection in a single prosecution. Applicants reiterate the applicable sections of the M.P.E.P. cited above in Section II.A of this Response.

D. Conclusion

For at least these reasons, Applicants respectfully request that the Examiner withdraw the finality of the Final Office Action to ensure that Applicants' response to these rejections and objections, made for the first time in this Final Office Action (which were not provoked by any amendments made by Applicants in the previous Response), are properly considered in compliance with the above-referenced M.P.E.P. sections. Applicants recognize that the Examiner is undoubtedly responsible for the examination of a large number of applications, placing inordinate constraints on the Examiner's time; however, Applicants respectfully submit that they should not be penalized for this fact and are still entitled to an examination of this Application in compliance with all applicable rules and guidelines.

III. Claims 8-18 and 29-30 Recite Patentable Subject Matter

The Examiner rejects Claims 8-18 and 29-30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Although Applicants believe Claims 8-18 and 29-30 are directed to patentable subject matter without amendment, Applicants have amended independent Claims 8 and 29 to further clarify that these claims each recite a computer-implemented method performed using one or more computer systems and are directed to patentable subject matter and are clearly directed to patentable subject matter. These amendments are not considered narrowing or necessary for patentability. By making these amendments, Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action. Additionally, these amendments do not raise new issues and do not require the Examiner to perform a new search. Applicants respectfully request that these amendments be entered even if the Examiner does not withdraw the finality of the Final Office Action.

For at least these reasons, Applicants respectfully request that the Examiner withdraw the rejections of Claims 8-18 and 29-30 under 35 U.S.C. § 101.

IV. Claims 8-18 and 29-30 Comply with 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claims 8-18 and 29-30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner rejects Claims 8-18 and 29-30 under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. Applicants respectfully disagree.

Applicants believe Claims 8-18 and 29-30 are definite without amendment in that the meaning of these claims would be clear to one of ordinary skill in the art such that these claims comply with 35 U.S.C. § 112, second paragraph. *See* M.P.E.P. § 2173.02. In any event, Applicants have made clarifying amendments to independent Claims 8 and 29 to more clearly indicate that these claims recite methods “for facilitating a commercial transaction involving a product” and that specifying to the seller a desired commercial transaction involving a particular product uniquely identified by a GUID “facilitat[es] the desired commercial transaction involving the particular product uniquely identified by the GUID.” These amendments are not considered narrowing or necessary for patentability. By making

these amendments, Applicants do not necessarily agree with or acquiesce to the Examiner's position that these claims omitted essential steps prior to the amendments presented in this Response. Additionally, these amendments do not raise new issues and do not require the Examiner to perform a new search. Applicants respectfully request that these amendments be entered even if the Examiner does not withdraw the finality of the Final Office Action.

For at least these reasons, Applicants respectfully request that the Examiner withdraw the rejection of Claims 8-18 and 29-30 under 35 U.S.C. § 112, second paragraph.

V. The Double Patenting Objection to Claim 29 should be Withdrawn

The Examiner objects Claims 29 under 37 CFR 1.75 as being a substantial duplicate of Claim 9. Applicants respectfully disagree.

At the outset, Applicants note that Claims 29 includes identical limitations to those recited in independent Claim 8, but does not include identical limitations to those recited in Claim 9 as indicated by the Examiner. (See Office Action, Page 8) Dependent Claim 9 recites, in relevant part, that "the CID comprises a class number of a first product class concatenated with class numbers of one or more product classes of the first product class which are at higher levels in the class hierarchy than the first product class." In contrast, independent Claim 29 recites, in relevant part, that "the CID compris[es] a class number of a first product class concatenated with class numbers of a plurality of parent product classes of the first product class which are at higher levels in the class hierarchy than the first product class." In any event, although Applicants do not necessarily agree that "Claim 29 contains the exact limitations of Claim 8, plus the additional limitation of Claim 9," as asserted by the Examiner, Applicants have amended Claim 29 to include a combination of limitations not explicitly recited in any combination of Claims 8-18. These amendments are not considered necessary for patentability. Additionally, these amendments do not raise new issues, do not require the Examiner to perform a new search. Applicants respectfully request that these amendments be entered even if the Examiner does not withdraw the finality of the Final Office Action.

For at least these reasons, Applicants respectfully request that the Examiner withdraw the double patenting objection to Claim 29.

VI. Claims 8-18 and 29-30 are Allowable over *Riordan*

The Examiner rejects Claims 8-18 and 29-30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,078,891 to Riordan, et al. ("*Riordan*"). Applicants respectfully disagree.

Riordan is directed to a system and method for efficient collection and organization of marketing data. (Column 2, Lines 9-10) The system disclosed in *Riordan* simultaneously captures at the point of sale all financial and non-financial data pertaining to a specific customer transaction. (Column 2, Lines 11-13) An electronic invoice is constructed from the captured data and transmitted to a credit authorization location via a communication link necessarily established to transmit a credit authorization request for the transaction. (Column 2, Lines 13-17) The electronic invoice contains line item data for each item purchased as part of the transaction. (Column 2, Lines 17-19) The credit authorization location receives the transmitted electronic invoice and forwards the invoice to a data warehouse. (Column 2, Lines 25-27) The data warehouse comprises a plurality of related data structures for storing the received data, which permit simple and flexible analysis and searching of the collected marketing data. (Column 2, Lines 28-31)

However, *Riordan* fails to disclose, teach, or suggest various limitations recited in Claim 8.

For example, *Riordan* fails to disclose, teach, or suggest "***communicating a globally unique identifier (GUID) for a particular product to a seller of the particular product***," as recited in Claim 8. The Examiner apparently equates the unique universal identification code (UIDC) disclosed in *Riordan* to the GUID recited in Claim 8. (See Office Action, Page 9) Even assuming for the sake of argument only that this equation could be made (which Applicants do not concede), *Riordan* would still fail to disclose, teach, or suggest "***communicating a globally unique identifier (GUID) for a particular product to a seller of the particular product***," as recited in Claim 8.

At best, *Riordan* merely discloses communicating a unique product code (UPC) or other standard code to the seller of a product at the point of sale. For example, in the Internet purchasing embodiment of the system disclosed in *Riordan*, a customer “selects the items he desires to purchase. Illustratively, the merchant’s website may comprise an interface which displays information regarding items offered for sale and may, for example, permit a customer to select items for purchase by clicking on icons or by typing in the identification number or name of particular items.” (Column 4, Lines 36-42) In describing the same embodiment, *Riordan* further discloses that “POS computer 120 creates an electronic invoice from the information entered by the customer.” (Column 5, Lines 1-2) “Each line item entry in the listing comprises the identity of the purchased item, the cost of the item, and the number purchased of the item. Typically, the identity of the item is represented by an identification code such as a UPC number [or other standard code] which is retrieved by POS computer from inventory database 127.” (Column 5, Lines 4-9; *see also* Column 5, Lines 35-37) As another example, in the in-store embodiment of the system disclosed in *Riordan*, a customer selects, in the store, items to be purchased and brings them to a point-of-sale terminal, where an employee of the merchant uses a product scanner to scan a bar code or other code printed on the item into a point-of-sale computer. (*See* Column 6, Line 65 through Column 7, Line 3)

However, *Riordan* fails to disclose, teach, or suggest communicating the UIDC disclosed in *Riordan* to the merchant or seller. Instead, *Riordan* discloses that the UIDC is merely stored in a data structure 602 of a data warehouse 185 associated with a credit authorization computer 170. (*See* Column 7, Line 61 through Column 8, Line 61) In particular, *Riordan* states, “Data warehouse 185 further comprises a data structure 602 which stores universal identification codes for every product stored in data warehouse 185.” (Column 7, Lines 61-63) Data warehouse 185 also comprises a data structure 610 for storing information regarding each line item on the received electronic invoice which was communicated from the point-of-sale computer (which includes the product code field, typically the UPC or other standard code for the purchased item). (*See* Column 7, Lines 47-56; Column 5, Lines 55-60) *Riordan* further discloses, “Once a hierarchical coding scheme is adopted, each product or service stored in warehouse 185 (as identified by a unique UPC

number) is assigned one or more UIDCs corresponding to the product categories to which the product or service belongs.” (Column 8, Lines 54-58) Thus, the data warehouse associated with the credit authorization computer stores a mapping of the UPC of products to the appropriate UIDC of the product that the UPC identifies. This hierarchical scheme and mapping “facilitates search and analysis of the collected marketing data stored in data warehouse 185” (Column 8, Lines 12-14), which occurs after the sale has transpired and is unrelated to facilitating a desired commercial transaction involving the product identified by the UIDC. What is communicated to the credit authorization computer from the point-of-sale computer is the line item data of an invoice, which includes the UPC or other standard product identifier, because this is the only information that the store has for identifying the product. *Riordan* fails to disclose, teach, or suggest that the UIDC is communicated to the seller of the product that is identified by the UPC. Thus, *Riordan* clearly fails to disclose, teach, or suggest “***communicating a globally unique identifier (GUID) for a particular product to a seller of the particular product,***” as recited in Claim 8.

As another example, *Riordan* fails to disclose, teach, or suggest “a class identifier (CID) that uniquely identifies at least one product class in which the product is categorized, along with a plurality of other products, within ***a class hierarchy of a global content directory for a distributed plurality of seller databases, each seller database being associated with a corresponding seller and distinct from other seller databases in the distributed plurality of seller databases,*** the product class defining one or more attributes of the products categorized in the class,” as recited in Claim 8. Figures 1 and 2 of *Riordan* make clear that any product data is merely stored in a single data warehouse 185 associated with credit authorization computer 170. Thus, *Riordan* necessarily fails to disclose, teach, or suggest “***a class hierarchy of a global content directory for a distributed plurality of seller databases, each seller database being associated with a corresponding seller and distinct from other seller databases in the distributed plurality of seller databases,***” as recited in Claim 8.

As disclosing these limitations, the Examiner argues that *Riordan* “discloses that the database further includes information pertaining to each retailer’s identification and location (col 10, lines 25-36), thus, disclosing that the directory database pertains to a plurality of

sellers and seller databases.” (Office Action, Page 9) Applicants respectfully disagree with the Examiner’s interpretations of *Riordan*. The cited portion of *Riordan* merely discloses that data warehouse 185, which is associated with the credit authorization computer, “comprises a data structure 609 which links particular retailing locations to particular retailing companies, since each retailer may maintain more than one retailing location.” (Column 10, Lines 24-27) According to *Riordan*, each record in data structure 609 includes: (1) a retailer identification field, which stores the identification number of the retailer which maintains the retail location; and (2) a retail location identification field, which stores the unique identifier typically allocated by credit authorization location 165 to identify a retail location. (See Column 10, Lines 28-36) This excerpt from *Riordan* merely discloses that data warehouse 185 may store information for a number of sellers, including the identity of the retailer and the location of the retailer. The location of the retailer is presumably the physical location of the retailer. There is certainly nothing in *Riordan* to suggest otherwise. Thus, the cited excerpt of *Riordan* does not lead to the conclusion that *Riordan* discloses “that the directory database pertains to a plurality of . . . seller databases,” as argued by the Examiner. (See Office Action, Page 9) Thus, *Riordan* clearly fails to disclose, teach, or suggest “**a class hierarchy of a global content directory for a distributed plurality of seller databases, each seller database being associated with a corresponding seller and distinct from other seller databases in the distributed plurality of seller databases,**” as recited in Claim 8.

Therefore, while *Riordan* may disclose “a hierarchical coding scheme in which each portion of a code identifies a significant characteristic of the product,” (Column 8, Lines 7-9), nowhere does *Riordan* disclose, teach, or suggest at least the limitations set forth above and recited in Claim 8.

Applicants respectfully note that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. § 2131. Stated another way, “for anticipation under 35 U.S.C. 102, the reference must teach **every aspect** of the claimed invention either explicitly or impliedly.” M.P.E.P. § 706.02 (emphasis added). In addition, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (emphasis

added) referencing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *see also Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, “[t]he ***identical invention*** must be shown in as complete detail as is contained in the . . . claim.” M.P.E.P. § 2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). As Applicants demonstrated above, *Riordan* fails to disclose, teach, or suggest, either expressly or inherently, each and every limitation recited in Claim 8. Thus, Claim 8 is clearly allowable over *Riordan*.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 8 and its dependent claims. For analogous reasons, Applicants respectfully request reconsideration and allowance of independent Claims 29 and its dependent claim.

VII. No Waiver

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the reference cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicants are clearly sufficient to overcome the Examiner’s rejections.

Conclusion

For at least the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this Application in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicants, at the Examiner's convenience at (214) 953-6812.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Christopher W. Kennerly
Reg. No. 40,675

Date: November 17, 2004

Customer No. **05073**